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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,120	03/17/2004	Brian D. Cunningham	MESS-001/00US 307102-2003	5291
58249 7590 09/23/2008 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			EXAMINER JAKOVAC, RYAN J	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 09/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,120	Applicant(s) CUNNINGHAM, BRIAN D.	
	Examiner RYAN J. JAKOVAC	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/25/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Random generation of identification data is not enabled by the disclosure.

2. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Random generation of identification data is not mentioned in the original disclosure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 31-34, 36, 38-51, 53, and 56-84 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0076220 to Zhang et al (hereinafter Zhang).

Regarding claim 31, 42, Zhang teaches a method comprising: associating with an electronic message authorized by an originator identification data uniquely identifying said electronic message (Zhang, [0058-0061], email is sent containing the sending address and senders fingerprint key.); storing said identification data (Zhang, [0058-0061], information identifying the sender including address and fingerprint key.); sending to an intended recipient said electronic message with said identification data (Zhang, [0058-0061], the email is sent.); receiving a confirmation request including said identification data (Zhang, [0058-0061], a message is sent with an encoded string to verify the sender which includes the senders email address, the recipients email address, an identification code, and the senders fingerprint key.); comparing said identification data received in said confirmation request to said stored identification data (Zhang, [0058-0061], fingerprint key is matched with records.); and upon determining that said identification data received in said confirmation request matches said stored identification data, responding to said confirmation request, affirming said electronic message was authorized by the originator (Zhang, [0058-0061], acknowledgement is sent.).

Regarding claim 32, 33, 36, 39, 40, 42, Zhang teaches the method of claim 31, wherein said electronic message includes one of an email, text message, VoIP message, or instant message (Zhang, abstract, fig. 1, email along with message text. See also, [0058-0061].).

Regarding claim 34, 51, Zhang teaches the method of claim 31, wherein said identification data is included in a message header of said electronic message (Zhang, [0068].).

Regarding claim 38, 41, Zhang teaches the method of claim 31, wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication (Zhang, [0008], the system uses standard email protocols such as SMTP.).

Regarding claim 44, 45, Zhang teaches the method of claim 31, wherein said comparing is performed at a device different from a device at which said associating is performed (Zhang, [0058-0061], comparison by Email Chief.).

Regarding claim 46, Zhang teaches the system of claim 31, wherein said identification data is an alphanumeric string (Zhang, [0058-0061], sender email address, fingerprint key.).

Regarding claim 47, Zhang teaches a system comprising: a sending module operable to: send to an intended recipient an electronic message authorized by an originator and identification data uniquely identifying said electronic message, said identification data being stored for subsequent access (Zhang, [0058-0061], email is sent containing the sending address and senders fingerprint key. The outgoing server also transmits the email); and a confirming module operable to: receive a confirmation request including said identification data (Zhang, [0058-0061], a message along with data identifying the message is sent to confirm the sender.); compare said identification data received in said confirmation request to said stored

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identification data (Zhang, [0058-0061], the data in the message is compared to stored data.); and upon determining that said identification data received in said confirmation request matches said stored identification data, respond to said confirmation request, affirming said electronic message was authorized by the originator (Zhang, [0058-0061], if the identification message data matches the stored data, an acknowledgement message is sent.).

Regarding claim 48, 49, 53, 60, 61, Zhang teaches the system of claim 47, 49, wherein said sending module is operable to send to the intended recipient an electronic message that includes one of an email, text message, VoIP message, or instant message (Zhang, abstract, fig. 1, email along with message text. See also, [0058-0061].).

Regarding claim 50, Zhang teaches the system of claim 47, wherein said identification data is an alphanumeric string (Zhang, [0058-0061], sender email address, fingerprint key.).

Regarding claim 56, 57, Zhang teaches the system of claim 47, wherein said confirmation module is operable to receive said confirmation request via port-to-port communication (Zhang, [0008], the system uses standard email protocols such as SMTP.).

Regarding claim 58, Zhang teaches the system of claim 47, wherein said confirmation module is operable to receive said confirmation request as a confirming electronic message (Zhang, abstract, fig. 1, email along with message text. See also, [0058-0061].).

Regarding claim 59, Zhang teaches the system of claim 58, wherein said confirming electronic message is one of an email, text message, VoIP message, or instant message (Zhang, abstract, fig. 1, email along with message text. See also, [0058-0061].).

Regarding claim 62, 65-69, 72-75, Zhang teaches t method comprising: receiving a confirmation request to confirm that an electronic message sent to an intended recipient was authorized by an originator identified in the electronic message, the confirmation request including identification data purporting to uniquely identify the electronic message; searching a data store for said identification data; and upon determining that said data store does not contain said identification data, responding to said confirmation request, denying the electronic message was authorized by the originator (Zhang, [0058-0061], a message is sent in order to confirm the sender (i.e. confirmation message) which includes identification data. The data in the confirmation message is checked against stored records and if there is no match, such as the fingerprint key being invalid, the system sends a message accordingly.).

Regarding claim 63, 64, 70, 71, Zhang teaches the method of claim 62, 69, wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication (Zhang, [0008], the system uses standard email protocols such as SMTP.).

Regarding claim 76, 81, 83, Zhang teaches t method comprising: receiving from a sending device a first electronic message authorized by an originator, said first electronic message containing information identifying the originator (Zhang, [0058-0061], email is sent

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containing the sending address and senders fingerprint key.); sending to a confirmation device a first confirmation request (Zhang, [0058-0061], a message is sent in order to confirm the sender (i.e. confirmation message); receiving a response to said first confirmation request affirming said first electronic message was authorized by the originator (Zhang, [0058-0061], an acknowledgement is sent when the sender is authorized.); allowing said first electronic message to be further processed according to rules for processing of confirmed electronic messages directed to the intended recipient (Zhang, [0058-0061], authorized messages are passed on to the incoming mail server for further processing.); receiving from the sending device a second electronic message authorized by the originator, said second electronic message containing information identifying the originator; and sending to the confirmation device a second confirmation request (Zhang, abstract, [0058-0062], the system processes further messages in the same manner.).

Regarding claim 77, 82, 84, Zhang teaches the method of claim 76, 81, 83, wherein each of said first electronic message and said second electronic message includes one of an email, text message, VoIP message, or instant message (Zhang, abstract, fig. 1, email along with message text. See also, [0058-0061].).

Regarding claim 78, 79, Zhang teaches the method of claim 76, wherein said sending to a confirmation device includes sending said first confirmation request and said second confirmation request via port-to-port communication (Zhang, [0008], the system uses standard email protocols such as SMTP.).

Regarding claim 80, Zhang teaches the method of claim 76, wherein said confirmation device is a different device than said sending device (Zhang, [0058-0061], confirmation by Email Chief.).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 35, 37, 52, 54, and 55 rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang.

Regarding claim 35, 37, 52, 54, and 55, Zhang teaches the method of claim 31, 47, and 54. Zhang does not expressly disclose wherein said identification data is included as an attachment to said electronic message, wherein said identification data is random, or wherein said identification data includes a checksum for said message text. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the

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prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the descriptive material does not patentably distinguish the claimed invention.

Response to Arguments

7. Applicant's arguments with respect to claims 31-84 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJ/

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145